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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,984	12/07/2001	Ronald E. Dykes	21917-P003US	4963
28277	7590	03/17/2004	EXAMINER	
WINSTEAD SECHREST & MINICK P.C. 2400 BANK ONE CENTER 910 TRAVIS STREET HOUSTON, TX 77002			THALER, MICHAEL H	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 03/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,984

Applicant(s)

DYKES, RONALD E.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The disclosure is objected to because of the following informalities: On page 7, line 20, "3" should be "7". Appropriate correction is required.

Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 28 depends from claim 27.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 6 and 8 (of the claim, not the page), "therethrough" is confusing and inaccurate since the each opening does not extend completely through the guard. Claims 7, 14, 21 and 25 are indefinite for the same reasons. In claim 1, line 6, "for receiving the handle portion" is confusing and inaccurate since the opening at 22 receives threads 26 which are on the reduced diameter portion 18 rather

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than the handle portion 12 as claimed, noting page 8, lines 25-26 and page 10, lines 6-9 of the specification. Claim 7 is indefinite for the same reasons. In claim 14, line 6, "handle threads" is indefinite for similar reasons. In claim 21, line 19, "axial to" is not understood. In claim 21, line 16, "reduced diameter portion of the instrument handle" is confusing and inaccurate since the reduced diameter portion 18 is adjacent to rather than part of the instrument handle portion 12 as indicated on page 8, lines 22-23. In claim 26, lines 3-4, there is no antecedent basis for "the surgical knife".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-12, 14-21, 23, 25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mesa (5,254,128) in view of Webb et al. (5,830,226). As to claim 1, Mesa discloses body 10 having handle portion 12 and distal end 14 with instrument 16, guard member 20 and means 24 for locking the guard member in either an open or closed position. Mesa fails

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to disclose a grip on the guard member 20. However, Webb et al. teach that a slidable guard member for a scalpel should include a grip (at 42) to facilitate grasping thereof (col. 3, lines 57-61). It would have been obvious to include a grip on the Mesa guard so that it too would have this advantage. As to claim 2, for example, Mesa fails to disclose the guard member 20 being translucent. However, Webb et al. teach that a slidable guard member for a scalpel should be clear apparently to facilitate viewing the blade (col. 5, lines 41-45). It would have been obvious to make the Mesa guard translucent so that it too would have this advantage. As to claims 5, 6 and 11, the undulating hills between the grooves 42 of Mesa are ridges, bumps or protrusions. As to claims 7, 14, 21 and 25, Mesa fails to disclose a third opening on the guard member 20. However, Webb et al. teach that a slidable guard member for a scalpel should include a third opening (44 or 86) to facilitate full re-sterilization (col. 3, line 62 to col. 4, line 5 and col. 4, line 65 to col. 5, line 5). It would have been obvious to include a third opening on the Mesa guard translucent so that it too would have this advantage.

Claims 22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mesa (5,254,128) in view of Webb et al. (5,830,226) as applied to claims 21 and 25 above, and further in

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view of either Dotson et al. (4,414,974) or Schmidt (4,569,133). Mesa fails to disclose a plurality of protrusions on the guard member 20 which reduce the rolling capacity of the surgical knife. However, Dotson et al. teach that a slidable guard member for a scalpel should include protrusions (the peaks at the corners of the octagon shape which protrude radially outwardly more than the other portions of the guard as shown in figure 5) to reduce the rolling capacity of the surgical knife (col. 4, lines 51-63). It would have been obvious to include protrusions on the Mesa guard so that it too would have this advantage. Alternatively, Webb et al. teach that a rotatable member on a scalpel should include protrusions (best seen in figure 2) apparently to facilitate grasping thereof. It would have been obvious to include protrusions on the Mesa rotatable guard so that it too would have this advantage during screwing and unscrewing the threaded connection at 24/26 or 24/22. The protrusions inherently reduce the rolling capacity of the surgical knife.

Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
3/12/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731